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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,094	12/04/2001	Kurt R. Dahlberg	053727-5001-US	8029
9629	7590	03/09/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			NGUYEN, SON T	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,094

Applicant(s)

DAHLBERG ET AL.

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 and 18-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Son T. Nguyen
Prim. Exm 3643

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/21/03.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 2/27/04.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicants have canceled claims 17,37-46. Pending claims are 1-16,18-36.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The formulas 7-10 in the claims need to be listed, as in ingredients of the formulas.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-7,36** are rejected under 35 U.S.C. 102(b) as being anticipated by Romaine et al. (US 4,803,800).

For claim 1, Romaine et al. disclose an enriched mushroom compost supplement comprising the addition of a polysaccharide to a mushroom compost supplement (col. 9, lines 31-45, col. 10, lines 59-68).

For claim 2, since Romaine et al. employ polysaccharide in the supplement, the added polysaccharide will provides a significantly higher yield when compared to a supplement lacking the polysaccharide.

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For claim 3, Romaine et al.'s polysaccharide is selected from cellulose, straw, starch, hemicellulose, etc. (col. 5, Table A, col. 9, lines 41-42).

For claim 4, the polysaccharide of Romaine et al. contains cellulose or cellulose-containing ingredients (col. 5, Table A, col. 9, line 41).

For claim 5, since Romaine's compost supplement contains the same ingredient as that of the present invention, the supplement of Romaine should dampens or suppresses temperature surges during spawn run just as well as that of the present invention.

For claim 6, Romaine et al. do not mentioned anything about an additional antimicrobial, therefore, Romaine's supplement does not require the antimicrobial.

For claim 7, since Romaine's compost supplement contains the same ingredient as that of the present invention, the supplement of Romaine should suppresses or reduces the growth of pest and pathogen microorganisms.

For claim 36, Romaine's cellulose have been treated (col. 5, Table A, the cellulose contains polymers such as ethyl succinylated, methyl, hydroxyethyl, etc. which means that the cellulose was treated with these polymers).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 8-16,18-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Romaine et al. (as above).

For claim 8, Romaine et al. teach a plurality of supplements which one can use (col. 9, lines 31-45), but they are silent about the supplement consisting solely of polysaccharides. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use solely polysaccharides in the supplement of Romaine et al. depending on the required nutrient/supplement desired for the particular type of mushrooms. Note, Romaine et al. never stated that the supplement consisted of multiple substances mixed together. Romaine et al. merely gave a list of nutrient supplement (col. 9, lines 31-45) which one could use either solely or mixed together depending on the require nutrient desired.

For claims 9-16, Romaine et al. are silent about various quantities or proportions of polysaccharides to use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ various quantities or proportions of polysaccharides of Romaine et al., since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claims 18-27, Romaine et al. are silent about certain formulas and their quantities or proportions to be used in the supplement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ various formulas in the supplement of Romaine et al. depending on the required

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nutrient/supplement desired for the particular type of mushrooms. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ various quantities or proportions in the supplement of Romaine et al., since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 28, Romaine et al. disclose a method of increasing mushroom yield comprising the steps of adding an enriched supplement such as polysaccharides to a mushroom compost (see explanation for claim 1); allowing the development of the mushrooms (col. 4, line 22). However, Romaine et al. do not specifically teach harvesting the mature mushrooms. It is well known in the agriculture industry, esp. in mushrooms, that once a mushroom is fully developed, it is harvested. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the step of harvesting the mature mushrooms in the method of Romaine et al. because it is notoriously well known in the art that when one grows mushrooms into fully mature mushrooms, one has to harvest the mushrooms for either sales or to provide space for other mushroom experimentation.

For claim 29, see explanation for claim 2.

For claim 30, Romaine et al.'s mushroom is a Basidiomycete (col. 28, Table XII).

For claim 31, Romaine et al.'s mushroom is a fleshy Basidiomycete (col. 28, Table XII).

For claim 32, et al.'s mushroom is selected from the group as claimed (col. 28, Table XII).

For claims 33-35, Romaine et al. disclose a method of supplementing a mushroom compost comprising the steps of adding an enriched supplement such as polysaccharides to a mushroom compost (see explanation for claim 1). However, Romaine et al. are silent about various quantities or proportions of polysaccharides to use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ various quantities or proportions of polysaccharides of Romaine et al., since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

8. Applicant's arguments filed 11/21/03 have been fully considered but they are not persuasive.

Applicants argued that The Office Action repeatedly refers to the Romaine et al. material as an enriched mushroom compost supplement." Respectfully, at no time do Romaine et al. describe anything in the reference as an enriched mushroom compost supplement" and nothing in Romaine et al. discloses an enriched mushroom compost supplement, either by name or by implication. Let analyze the claim language of the present invention to see if Romaine et al. anticipate in what is presently being claimed: "An enriched mushroom supplement, wherein the

enrichment comprises the addition of a polysaccharide or polysaccharide composition to a mushroom compost supplement. The mushroom compost in Romaine et al. is listed in col. 10, lines 65-68, such as straw, wood, wood chips, sawdust, etc. The supplement added to this compost in Romaine et al. is listed in cols. 5,6, 7,8 such as polymers, minerals, rice hulls, etc. And finally, the enrichment is the polysaccharide or polysaccharide composition as listed in col. 9, lines 31-35. Therefore, every limitation of the present claim language is anticipated by Romaine et al.

All other arguments were addressed in the Final Rejection dated 7/21/03.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to

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5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.



Son T. Nguyen
Primary Examiner, GAU 3643
March 5, 2004